



JAN 30 2002

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In re Application of
TEMSAMANI, Jamal, et al.
Application No.: 09/856,940
PCT No.: PCT/FR99/02939
Int. Filing Date: 26 November 1999
Priority Date: 30 November 1998
Attorney Docket No.: 19904-013NATL
For: PHARMACEUTICAL
COMPOSITION COMPRISING
AN ANTI-CANCER AGENT AND
AT LEAST A PEPTIDE

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is a decision on applicants' "Petition and Statement of Facts In Support of Filing On Behalf of Nonsigning Inventors (37 C.F.R. §1.47)," filed in the United States Patent and Trademark Office (USPTO) on 06 December 2001.

BACKGROUND

On 26 November 1999, applicants filed international application PCT/FR99/02939, which claimed a priority date of 30 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 June 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 30 June 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 May 2001.

On 30 May 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 10 July 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for reply.

On 06 December 2001, applicants submitted the instant petition under 37 CFR 1.47, which was accompanied by, *inter alia*, a petition for a three-month extension of time; the fee for a

three-month extension of time; and a combined declaration and power of attorney executed by inventors Jamal Temsamani and Michel Kaczorek.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1) and (4) have been met. (1) The petition fee of \$130 has been paid. (4) The declaration submitted is accepted as complying with 37 CFR 1.47(a).

Item (2) has not been met. Applicants are asserting that the nonsigning inventor cannot be reached after diligent effort. It is noted that had this petition been based on the refusal of inventors to sign the declaration, applicants would have had to demonstrate that *bona fide* attempt was made to present a copy of the application papers to the inventors. MPEP 409.03(d).

Under 37 CFR 1.47(a), the petition must supply proof of pertinent facts. It is noted that "copies of documentary evidence, such as a internet searches, certified return mail receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached" should be included. MPEP §409.03(d). Such documentary evidence has not been submitted. It is further noted that applicants state in their petition that "[c]opies of letters sent to inventor Annick Colin de Verdiere (in French and translated into English) requesting her signature on the Declaration form, and evidence of delivery issued from the French Mail Service are attached hereto." However, no such materials are in the file, nor are they listed on the transmittal letter that accompanied this petition.

The only statement included is the petition signed by Barry J. Marenberg. It states:

Our French patent associate at Breese-Majerowicz has informed us that SYNT:EM has communicated that inventor Annick Colin de Verdiere is no longer employed at SYNT:EM and our French patent associate has not succeeded in locating or contacting inventor Annick Colin de Verdiere at her last known residence address. Accordingly, a diligent effort to reach inventor Annick Colin de Verdiere has been made in accordance with 37 C.F.R. 1.47(a).

However, "a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made." MPEP §409.03(d). The statement of Marenberg is general and is second hand. It recites what was told "us." "The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein." MPEP §409.03(d). In this case, it would appear that the statement of facts needs to

come from the French patent associate. Further, such a statement should outline what additional steps (*e.g.* telephone search, internet search, *etc.*) were taken to locate the missing inventor beyond merely attempting contact at the last known address.

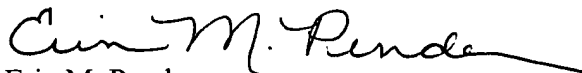
Item (3) has not been met. Applicants list two home addresses and one business address as the last known addresses of Annick Colin de Verdiere. Applicant must state which residence is "the" last address.

CONCLUSION

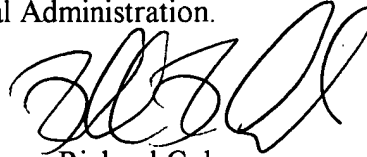
For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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